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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,230	12/08/2000	Yoshifumi Tanimoto		1021

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EXAMINER

LETT, THOMAS J

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/733,230	Applicant(s) TANIMOTO, YOSHIFUMI	
	Examiner Thomas J. Lett	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-12 and 14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed 22 May 2006 have been fully considered but they are not persuasive. Applicant argues "that the prior art of Council does not teach or suggest accepting a request for data transfer if the e-mail is received over LAN and denying the request if the e-mail is received over the internet. There is no distinction between receipt of the email over a LAN of the Internet, rather, Council is concerned only with whether a particular email address has authorized billing. Council does not provide or suggest the security prevention of misuse) features of applicant's invention."

Examiner does not rely upon Council to teach or suggest each and every feature of the claimed invention. For a claim rejection under 35 USC § 103 purposes, Examiner is relying on the teaching that Council refers to information contained in a datagram to handle/authorize the data transfer of an email communication so that a user can gain access to the message. The prior art of Council can make the discrimination preferably at the ISP (col. 3, lines 37-38). The ISP can choose whether or not to accept the email addresses (col. 4, lines 8-12) that are part of the LAN (col. 3, lines 32-34) based on a list and can choose whether or not to accept the addresses that are part of a public network.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2625

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-8, 10-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Council (USPN 6,192,114 B1) in view of Taylor (USPN 5,922,071 A).

With respect to claim 1, Council discloses a facsimile machine (computer, col. 4, lines 1-5) connectable to PSTN (public communication, col. 3, lines 42-53) and another network (LANs and WANs, col. 3, lines 32-34) and adapted to receive data from a data transmitter (DTE 1, col. 3, lines 15-20) over the another network (LANs and WANs, col. 3, lines 32-34) and transfer the data to a recipient (user of DTE 8), comprising:

a memory (source address list, col. 4, lines 1-7) for storing delivery conditions, including whether or not a request for data transfer should be accepted, in accordance with at least part of an address of a data transmitter (DTE 1, col. 3, lines 15-20); and

a control unit (computer, col. 4, lines 1-5) for determining whether the request for data transfer should be accepted, based on the address of the data transmitter (source address of DTE 8, col. 4, line 4), wherein the another network includes LAN and internet (LANs and WANs, col. 3, lines 32-34), the data is an e-mail (col. 3, lines 62-65), and the control unit accepts the request for data transfer if the e-mail is received over LAN (col. 4, lines 8-12) and does not accept the request for data transfer if the e-mail is received over the internet (col. 4, lines 17-23).

Council does not disclose determining whether the request for data transfer should be accepted based on the delivery conditions.

Taylor et al disclose storing delivery conditions (see Fig. 140 indicating a time and date schedule to deliver a facsimile) to transfer data.

Council and Taylor et al are analogous art because they are from the similar problem solving area of data transfer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the scheduling feature of Taylor et al to the memory of Council in order to obtain a data transfer scheduler. The motivation for doing so would be to permit a data transfer at a certain time period.

With respect to claim 2, Council discloses a facsimile machine (computer, col. 4, lines 1-5) connectable to PSTN and another network (LANs and WANs, col. 3, lines 32-34) and adapted to receive data from a data transmitter (DTE 1, col. 3, lines 15-20) over the another network and transfer the data to a recipient (user of DTE 8) comprising:

- a memory (source address list, col. 4, lines 1-7) for storing delivery conditions including recipients registered in accordance with at least part of an address of a data transmitter (DTE 1, col. 3, lines 15-20); and

- a control unit (computer, col. 4, lines 1-5) for determining a recipient of data, based on the address of the data transmitter (source address of DTE 8, col. 4, line 4), and transferring the data to the determined recipient (user of DTE 8), wherein the another network includes LAN and internet (LANs and WANs, col. 3, lines 32-34), the data is an e-mail (col. 3, lines 62-65), and the control unit accepts the request for data transfer if the e-mail is received over LAN (col. 4, lines 8-12) and does not accept the request for data transfer if the e-mail is received over the internet (col. 4, lines 17-23).

Council does not disclose determining a recipient of data based on the delivery conditions.

Taylor et al disclose storing delivery conditions (see Fig. 140 indicating a time and date schedule to deliver a facsimile) to transfer data to a recipient.

Council and Taylor et al are analogous art because they are from the similar problem solving area of data transfer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the scheduling feature of Taylor et al to the memory of Council in order to obtain a data transfer scheduler. The motivation for doing so would be to permit a data transfer at a certain time period.

With respect to claim 3, does not disclose a facsimile machine wherein the delivery conditions include day and time of data transfer.

Taylor et al disclose storing delivery conditions (see Fig. 140 indicating a time and date schedule to deliver a facsimile) to transfer data.

Council and Taylor et al are analogous art because they are from the similar problem solving area of data transfer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the scheduling feature of Taylor et al to the memory of Council in order to obtain a data transfer scheduler. The motivation for doing so would be to permit a data transfer at a certain time period.

With respect to claim 5, Council discloses a facsimile machine wherein the recipient is specified by a facsimile number or e-mail address (computer compares source addresses, col. 4, lines 1-5).

With respect to claim 6, Council discloses a facsimile machine of claim 2, wherein the controller (computer analyzes source addresses and see decision block 15 of Fig. 2, col. 4, lines 1-5) can transfer the data to a plurality of recipients.

With respect to claim 7, Council discloses a facsimile machine of claim 6, wherein the recipients are specified by facsimile numbers and e-mail addresses (computer compares source addresses, col. 4, lines 1-5 and see decision block 15 of Fig. 2. Examiner notes that communications protocols include public networks (e.g., PSTN for fax numbers) as well as TCP/IP (for email addresses), col. 3, lines 42-53).

With respect to claim 8, Council does not disclose a facsimile machine of claim 2, wherein the recipients include a printer connected to the another network.

Taylor et al disclose a printer selector (see Figs. 14A-C with a pulldown menu for designating a default printer on a network(s) for a facsimile).

Council and Taylor et al are analogous art because they are from the similar problem solving area of print data transfer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the print pulldown feature of Taylor et al to the apparatus of Council in order to obtain a method of selecting a printer on a certain network. The motivation for doing so would be to choose a desired printer.

With respect to claim 10, Council discloses a data transfer method comprising the steps of:

A) receiving data over a network (computer at ISP 5 receives data from Internet 4, col. 3, lines 12-25); and

B) determining whether the data should be transferred to a designated recipient based on an address of a data transmitter (col. 3, lines 12-25), wherein the network includes LAN and internet (LANs and WANs, col. 3, lines 32-34), the data is an e-mail, and the step B determines that the data should be transferred if the e-mail is received

over LAN and that the data should not be transferred if the e-mail is received over the internet (the system of Council is implemented to selectively decide which emails are received by the intended recipient over the LANs and WANs, col. 2, lines 8-15).

Council does not disclose determining whether the data should be transferred to a designated recipient based on predetermined delivery conditions.

Taylor et al disclose storing delivery conditions (see Fig. 140 indicating a time and date schedule to deliver a facsimile) to transfer data.

Council and Taylor et al are analogous art because they are from the similar problem solving area of data transfer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the scheduling feature of Taylor et al to the computer 5 of Council in order to obtain a data transfer scheduler. The motivation for doing so would be to permit a data transfer at a certain time period.

With respect to claim 11, Council discloses a data transfer method of claim 10 further including the step of transferring the data to the designated recipient according to determination made in the step B (the system of Council is implemented to selectively decide which emails are transferred by the intended recipient over the LANs and WANs, col. 2, lines 8-15).

With respect to claim 12, Council discloses a data transfer method of claim 10, wherein the predetermined delivery conditions include day and time of data transfer.

Taylor et al disclose storing delivery conditions (see Fig. 140 indicating a time and date schedule to deliver a facsimile) to transfer data.

Council and Taylor et al are analogous art because they are from the similar problem solving area of data transfer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the scheduling feature of Taylor et al to the computer 5 of Council in order to obtain a data transfer scheduler. The motivation for doing so would be to permit a data transfer at a certain time period.

With respect to claim 14, Council discloses a data transfer method of claim 10, wherein the recipient is a printer connected to the network.

Taylor et al disclose a printer selector (see Figs. 14A-C with a pulldown menu for designating a default printer on a network(s) for a facsimile).

Council and Taylor et al are analogous art because they are from the similar problem solving area of print data transfer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the print pulldown feature of Taylor et al to the apparatus of Council in order to obtain a method of selecting a printer on a certain network. The motivation for doing so would be to choose a desired printer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571) 272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJL



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PRIMARY EXAMINER